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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HEWLETT-PACKARD COMPANY
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EXAMINER

THOMPSON, JAMES A

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/896,878	Applicant(s) THOMASON, TAMRA L.	
	Examiner James A Thompson	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because the abstract contains legal claim language, reciting two aspects of the present invention. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1-6, 9-11, 13 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid (US Patent 5,659,164) in view of Walsh (US Patent 5,496,071).

Regarding claims 1 and 10: Schmid discloses a device (figure 2A of Schmid) comprising means for electronically capturing content (figure 2A("Scanner(S)") and column 4, lines 36-42 of Schmid); means for electronically capturing information (figure 2A(R) and column 4, lines 28-33 of Schmid) pertinent to the captured content (column 4, lines 22-29 of Schmid); means for associating the content and the information (figure 2A("CP"(portion)) and column 4, lines 39-45 of Schmid); and means for transmitting the content and information to a device for manipulation (figure 2A("CP"(portion)) and column 4, lines 41-45 of Schmid). The computer (figure 2("CP") of Schmid) compiles all of the contents of a scan job together (column 4, lines 38-43 of Schmid), along with the information regarding said scan job (column 4, lines 22-29 of Schmid), thus associating said content and said information. The computer then transmits the content and information to a device (figure 2(CN) of Schmid) for manipulation (column 4, lines 41-45 of Schmid). Said means for associating and said means for transmitting correspond to the portion of the computer, along with the associated memory and physically embodied software, that perform the functions of said means for associating and said means for transmitting.

Schmid does not disclose expressly that said information is source information pertinent to the source of the captured content.

Walsh discloses printed electronic code data (figure 1(11) of Walsh) that stores relevant document information (column 5, lines 50-53 of Walsh) including source information pertinent to

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the source of the document content (column 5, lines 53-55 and lines 40-43 of Walsh).

Schmid and Walsh are combinable because they are from similar problem solving areas, namely the electronic storing, sorting and organizing of document data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the source information taught by Walsh in the bar-coded cover information taught by Schmid. The motivation for doing so would have been to properly index documents for ease of later retrieval (column 4, lines 5-12 of Walsh).. Therefore, it would have been obvious to combine Walsh with Schmid to obtain the invention as specified in claims 1 and 11.

Further regarding claim 1: The device of claim 10 performs the method of claim 1.

Regarding claim 2: Schmid discloses that the step of electronically capturing the content and source information comprises capturing the content and source information with a common scan head of a scanning device (column 4, lines 28-35 of Schmid). If the MRI code reader is internally embedded in the scanner (column 4, lines 28-35 of Schmid), then said content and said source information are captured with a common scan head of the scanning device.

Regarding claim 3: Schmid discloses that the step of electronically capturing the content and source information comprises capturing the content and source information with separate text and data code scan heads, respectively, of a scanning device (column 4, lines 28-35 of Schmid). If the MRI code reader is external to the scanner (column 4, lines 28-35 of Schmid), then said content and said source information are

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captured with separate text and data code scan heads, respectively, of the scanning device.

Regarding claim 4: Schmid discloses that the step of electronically capturing source information comprises scanning a bar code of the source (figure 1(MRI) and column 4, lines 23-25 of Schmid).

Further regarding claim 5: Walsh discloses that said source information comprises bibliographic information pertinent to the source (column 3, lines 5-11 of Walsh).

Further regarding claim 6: Walsh discloses that said source information comprises information that can be used to retrieve bibliographic information pertinent to the source (column 3, lines 5-11 of Walsh).

Regarding claims 11 and 19: Schmid discloses a system (figure 2A of Schmid) comprising means for receiving content (figure 2A("Scanner(S)")) and column 4, lines 35-42 of Schmid) and associated information (column 4, lines 28-33 of Schmid) pertinent to the content in electronic form (column 4, lines 22-29 of Schmid); means for reconfiguring the content and associated information (figure 2A ("CP"(portion)) and column 4, lines 38-43 of Schmid) for use in a user application (column 4, lines 43-45 of Schmid); and means for automatically creating at least one identifier in the user application (figure 2A("CP"(portion)) and column 4, lines 22-29 of Schmid). Said means for reconfiguring and said means for automatically creating correspond to the portion of the computer (figure 2A("CP") of Schmid), along with the associated memory and physically embodied software, that perform the functions of said means for reconfiguring and said means for automatically creating.

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Schmid does not disclose expressly that said information is source information pertinent to the source of the content in electronic form; and that said identifier in the user application is a source acknowledgement.

Walsh discloses printed electronic code data (figure 1(11) of Walsh) that stores relevant document information (column 5, lines 50-53 of Walsh) including source information pertinent to the source of the document content (column 5, lines 53-55 and lines 40-43 of Walsh); and source acknowledgements (column 5, lines 53-55 and lines 40-43 of Walsh).

Schmid and Walsh are combinable because they are from similar problem solving areas, namely the electronic storing, sorting and organizing of document data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the source information taught by Walsh in the bar-coded cover information taught by Schmid. Thus, the identifier automatically generated by the system of Schmid would be at least one source acknowledgement, as taught by Walsh. The motivation for doing so would have been to properly index documents for ease of later retrieval (column 4, lines 5-12 of Walsh). Therefore, it would have been obvious to combine Walsh with Schmid to obtain the invention as specified in claims 11 and 19.

Further regarding claim 11: The system of claim 19 performs the method of claim 11.

Further regarding claim 13: Walsh discloses that the at least one source acknowledgement includes a bibliography (column 3, lines 5-11 of Walsh).

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Further regarding claim 17: Walsh discloses retrieving bibliographic information pertinent to the source using the source information (column 3, lines 5-11 of Walsh).

Regarding claims 9 and 18: Schmid discloses the step of performing optical character recognition on the content (column 5, lines 5-8 of Schmid).

4. Claims 7-8 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid (US Patent 5,659,164) in view of Walsh (US Patent 5,496,071) and Nurse (US Patent 5,097,418).

Regarding claims 7 and 16: Schmid discloses the step of capturing, and thus receiving, content information (column 4, lines 22-29 of Schmid).

Schmid in view of Walsh does not disclose expressly that said content information is content location information that identifies where the content was found in the source.

Nurse discloses content information is content location information that identifies where the content was found in the source (column 4, lines 19-23 of Nurse).

Schmid in view of Walsh is combinable with Nurse because they are from the same field of endeavor, namely the processing of digital document data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include content location information including where the content can be found in the source (such as page numbers), as taught by Nurse, in the content information taught by Schmid in view of Walsh. The motivation for doing so would have been to be able to organize the bibliographical information such that it can later be modified, edited or altered (column 1, line 66 to column 2, line 5 of Nurse). Therefore, it would have been

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obvious to combine Nurse with Schmid in view of Walsh to obtain the invention as specified in claims 7 and 16.

Further regarding claim 8: Nurse discloses that the content location information comprises one or more page numbers (column 4, lines 19-21 of Nurse).

Regarding claim 14: Schmid in view of Walsh does not disclose expressly that the at least one source acknowledgement includes a footnote.

Nurse discloses a source acknowledgement which includes a footnote (column 4, lines 19-23 of Nurse).

Schmid in view of Walsh is combinable with Nurse because they are from the same field of endeavor, namely the processing of digital document data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to specifically include a footnote as part of said source acknowledgement. The suggestion for doing so would have been that a footnote is another ordinary format for bibliographic citation. Therefore, it would have been obvious to combine Nurse with Schmid in view of Walsh to obtain the invention as specified in claim 14.

Regarding claim 15: Schmid in view of Walsh does not disclose expressly that the at least one source acknowledgement includes an endnote.

Nurse discloses a source acknowledgement which includes an endnote (column 4, lines 19-23 of Nurse).

Schmid in view of Walsh is combinable with Nurse because they are from the same field of endeavor, namely the processing of digital document data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to specifically include an endnote as part of said source

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acknowledgement. The suggestion for doing so would have been that an endnote is another ordinary format for bibliographic citation. Therefore, it would have been obvious to combine Nurse with Schmid in view of Walsh to obtain the invention as specified in claim 15.

5. Claims 12 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid (US Patent 5,659,164) in view of Walsh (US Patent 5,496,071) and Ellis (US Patent 6,218,964 B1).

Regarding claim 12: Schmid in view of Walsh does not disclose expressly receiving the content and associated source information with a handheld scanning device.

Ellis discloses a handheld scanning device (figure 1A; figure 6(10); and column 2, lines 39-42 of Ellis), which includes a power source, a scanner, a computer processor, memory, and other elements (figure 1A; and column 2, lines 42-48 and lines 52-54 of Ellis) necessary to perform scanning and image processing functions (column 3, lines 1-8 of Ellis).

Schmid in view of Walsh is combinable with Ellis because they are from the same field of endeavor, namely the processing of digital image data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to embed the power source, scanner, computer processor, memory and other elements necessary to perform scanning and image processing, which are taught by Schmid, in a handheld scanning device, as taught by Ellis. The motivation for doing so would have been that a handheld scanning device is useful for scanning portions of a book, article, picture, or other printed matter that is specifically desired and selected by a user. Therefore,

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it would have been obvious to combine Ellis with Schmid in view of Walsh to obtain the invention as specified in claim 12.

Regarding claim 20: Schmid discloses a scanning device (figure 2A of Schmid) comprising a scan head (figure 2A(S) of Schmid) that is adapted to capture information from a source (column 4, lines 35-42 of Schmid); and memory including an information association module (figure 2A(R) of Schmid) that is configured to associate captured content with captured information (column 4, lines 22-28 of Schmid).

Schmid does not disclose expressly that said scanning device is a handheld scanning device; a housing configured as a pen; and that said captured information is captured source information.

Walsh discloses printed electronic code data (figure 1(11) of Walsh) that stores relevant document information (column 5, lines 50-53 of Walsh) including document source information (column 5, lines 53-55 and lines 40-43 of Walsh).

Schmid and Walsh are combinable because they are from similar problem solving areas, namely the electronic storing, sorting and organizing of document data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the source information taught by Walsh in the bar-coded cover information taught by Schmid. The motivation for doing so would have been to properly index documents for ease of later retrieval (column 4, lines 5-12 of Walsh). Therefore, it would have been obvious to combine Walsh with Schmid.

Schmid in view of Walsh does not disclose expressly that said scanning device is a handheld scanning device; and a housing configured as a pen.

Ellis discloses a housing configured as a pen (figure 1A; figure 6(10); and column 2, lines 39-42 of Ellis). The reading pen includes a power source, a scanner, a computer processor, memory, and other elements (figure 1A; and column 2, lines 42-48 and lines 52-54 of Ellis) necessary to perform scanning and image processing functions (column 3, lines 1-8 of Ellis).

Schmid in view of Walsh is combinable with Ellis because they are from the same field of endeavor, namely the processing of scanned digital image data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to embed the power source, scanner, computer processor, memory and other elements necessary to perform scanning and image processing, which are taught by Schmid, in a housing configured as a pen, as taught by Ellis. The scanning device taught by Schmid in view of Walsh would then be a handheld scanning device. The motivation for doing so would have been that a scanner that is the size and shape of a pen is useful for scanning portions of a book, article, picture, or other printed matter that is specifically desired and selected by a user. Therefore, it would have been obvious to combine Ellis with Schmid in view of Walsh to obtain the invention as specified in claim 20.

Regarding claim 21: Schmid discloses that the device comprises two scan heads (column 28, lines 28-35 of Schmid), one of the scan head being adapted to capture text (column 4, lines 26-29 of Schmid) and the other scan head being adapted to capture data code information (column 4, lines 22-26 and lines 33-37 of Schmid). If the MRI code reader is external to the scanner (column 4, lines 28-35 of Schmid), then said content and said source information are captured with separate text and data

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code scan heads, respectively, of the scanning device. One scan head performs optical character recognition (column 4, lines 26-29 of Schmid) and is thus adapted to capture text. The other scan head scans and decodes the MRI code data (column 4, lines 22-26 and lines 33-37 of Schmid) and is thus adapted to capture data code information.

Schmid in view of Walsh does not disclose expressly that one scan head is provided at each end of the device.

Ellis discloses a scanner at one end of the handheld scanning device (figure 1A(22) and column 2, lines 45-48 of Ellis) and a microphone at the other end of the handheld device (figure 1A(24) and column 2, lines 49-51 of Ellis).

Schmid in view of Walsh is combinable with Ellis because they are from the same field of endeavor, namely the processing of scanned digital image data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to place one input device on one end of the handheld scanning device and another input device on the opposite end of the handheld scanning device, as taught by Ellis, one input device being the scan head adapted to capture text taught by Schmid and the other input device being the scan head adapted to capture data code information taught by Schmid. The suggestion for doing so would have been that the microphone and the scanner taught by Ellis are two different types of digital data input devices and the two scan heads taught by Schmid are also two different types of digital data input devices, since one scan head is adapted to capture text and the other scan head is adapted to capture data code information. Therefore, it would have been obvious to combine Ellis with Schmid in view of Walsh to obtain the invention as specified in claim 21.

Regarding claim 22: Schmid discloses a transceiver (figure 2A("Network Router") of Schmid) that is adapted to transmit captured information to another device for manipulation (column 4, lines 38-45 of Schmid).

Regarding claim 23: Schmid discloses an optical character recognition module (figure 2A("OCR(O)") of Schmid) stored in memory (column 5, lines 5-8 of Schmid).

6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid (US Patent 5,659,164) in view of Walsh (US Patent 5,496,071), Ellis (US Patent 6,218,964 B1), and Suzuki (US Patent 6,072,916).

Regarding claim 24: While it is reasonable to assume that the scan head taught by Schmid in view of Walsh and Ellis comprises a charge-coupled device (CCD), Schmid in view of Walsh and Ellis does not disclose expressly that the scan head comprises a charge-coupled device.

Suzuki discloses a scan head which comprises a charge-coupled device (CCD) (figure 1(28) and column 4, lines 28-32 of Suzuki).

Schmid in view of Walsh and Ellis are combinable with Suzuki because they are from the same field of endeavor, namely the processing of scanned digital image data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a charge-coupled device in the scan head, as taught by Suzuki. The motivation for doing so would have been that a charge-coupled device is the common and expected device used to capture image data for a digital scanning device. Therefore, it would have been obvious to

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combine Suzuki with Schmid in view of Walsh and Ellis to obtain the invention as specified in claim 24.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A Thompson whose telephone number is 703-305-6329. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on 703-308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Thompson
Examiner
Art Unit 2624

JAT
28 January 2005



THOMAS D.
LEE
PRIMARY EXAMINER